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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/539,152

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Andreas Muth

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05/14/2008

PRICE HENEVELD COOPER DEWITT & LITTON, LLP

695 KENMOOR, S.E.

P O BOX 2567

GRAND RAPIDS, MI 49501

EXAMINER

BUTLER, PATRICK NEAL

ART UNIT

PAPER NUMBER

1791

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/539,152

**Applicant(s)**

MUTH ET AL.

**Examiner**

Patrick Butler

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-48 is/are pending in the application.
- 4a) Of the above claim(s) 20-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-850)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 20050616

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant's Amendments, filed on 20 February 2008, and Accompanying Remarks, filed on 09 January 2008 and 20 February 2008, have been entered and have been carefully considered. Although Applicant indicates the Claims and Remarks are directed to Application number 11/539,152, the Examiner assumes their filing to be for Application Number 10/539,152 as indicated on Page 1 of Applicant's responses filed on 09 January 2008 and 20 February 2008.

### ***Election/Restrictions***

Applicant's election with traverse of Group II, claims 41-48, in the reply filed on 09 January 2008 and 20 February 2008 is acknowledged. The traversal is on the ground(s) that the disunity of invention is moot in view of Applicant's cancelling of Group III since Group II was relied upon for disunity of invention. Therefore, in view of Applicant's cancelling of Group III, claims 49-52, the restriction as set forth in the Office Action of 11 December 2007 is withdrawn.

### **Restriction is required under 35 U.S.C. 121 and 372:**

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 20-40, drawn to a device for producing insulation elements.

Group II, claims 41-48, drawn to a method of producing insulation elements.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The technical feature common to both groups is a device with a curing oven with a compacting device inside and a conveyor through it. This technical feature is taught by Morrison et al. (US Patent No. 2,997,096). Morrison teaches a curing oven 30 (curing oven) with an upper compression conveyor 32 (compacting device) and a conveyor 18 (a conveyor) (see col. 3, lines 19-35). Therefore, the common technical feature is not a contribution over the prior art; the groups lack the same or corresponding special technical features.

During a telephone conversation with Marcus Dolce on 05 May 2008, a provisional election was made with traverse to prosecute the invention of Group II, claims 41-48. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 41, 42, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Morrison et al. (US Patent No. 2,997,096).

With respect to Claim 41, Morrison teaches making a glass wool pack with a binding agent (a method of producing insulation elements made of mineral wool containing a curable binder) by delivering a fibrous glass web 16 onto a conveyor 18 (depositing insulation material on a conveyor) into and through a curing oven 30 (curing and transporting the insulation material through a curing oven) where it is from four inches to two inches by the compression conveyor 32 (subjecting sections of the insulation material to controlled compaction in such a manner that at least one permanent impression and/or deformation is produced in the insulation blanket while the insulation blanket is curing during its passage through the curing oven) (see fig. 1 and col. 3, lines 5-35).

With respect to Claim 42, the curing oven 28 is a tunnel furnace (see fig. 1).

With respect to Claim 44, the product is a glass wool pack (the mineral wool is glass wool) (see col. 3, lines 5-11).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison et al. (US Patent No. 2,997,096) as applied to claim 41 above, and further in view of Collins (US Patent No. 2,288,072).

With respect to Claim 43, Morrison et al. teach a method of curing a fibrous mass as previously described. Morrison teaches a method of making the fibrous mass of mineral material (see col. 9, line 55 through col. 10, line 5). Morrison does not appear to expressly teach that the mineral material is rock wool.

Collins teaches making bonded fibrous products of mineral wool such as glass wool or rock wool (see page 1 of text, left column, lines 1-20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Collins's rock wool with Morrison's method of making a mineral wool pack in order to provide a product of high temperature stability.

Claims 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison et al. (US Patent No. 2,997,096) as applied to claim 41 above, and further in view of Eriksson et al. (International Publication Number WO 00/44540).

With respect to Claims 45-48, Morrison et al. teach a method of curing a fibrous mass as previously described. Morrison does not appear to expressly teach shaping the pack into a non-rectangular cross-sectional profile with at least one depression or projection and displaying two parallel recesses before or during curing and compacting to varying degrees whereby a density within the insulation elements varies accordingly.

Eriksson teaches shaping a fiber mat 3 by compressing with profiled cutting roll 6 and steam roll 7 having varying diameters (see page 2, lines 14-26 and fig. 1), which

would compact more in the parallel channels of higher diameter on the cutting roll 6 and steam roll 7 (shaping the pack into a non-rectangular cross-sectional profile with at least one depression or projection and displaying two parallel recesses before or during curing and compacting to varying degrees whereby a density within the insulation elements varies accordingly).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Eriksson's shaping roll 7 in Morrison's method of making a fibrous mass in order to make a profiled product without having to shape post-curing (see Eriksson, page 1, lines 20-28 and page 3, lines 21-26).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Butler whose telephone number is (571) 272-8517. The examiner can normally be reached on Mon.-Thu. 7:30 a.m.-5 p.m. and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. B./

Examiner, Art Unit 1791

/Monica A Huson/

Primary Examiner, Art Unit 1791